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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/976,579 11/24/97 THORNTON

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EXAMINER

TM02/1215

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ART UNIT

PAPER NUMBER

2131

DATE MAILED:

12/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademark

Office Action Summary

Application No.

08/976,579

Applicant(s)

THORNTON ET AL.

Examiner

Anthony DiLorenzo

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

RESPONSE TO AMENDMENT AND REMARKS

This Office Action is written in response to the Preliminary Request for Reconsideration filed on September 26th 2000 in U. S. Continuing Prosecution Application Serial No. 08/976579. Claims 1-27 have been examined on the merits in light of the presented responses.

The appropriate sections of Title 35 of the U.S. Code not appearing in this communication have been cited in a previous office action.

Claim Rejections

The rejections are detailed below in relation to each claim. Rejections of dependent claims necessarily incorporate the rejections of the base claims and any intervening claims. Similar claims are grouped together.

► Under 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5, 6, 8-12, 14, 15, 17-21, 23, 24, 26, and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Zdybel et al. '686.

Independent claims 1, 10, and 19:

Zdybel discloses a system and method for transferring digital data via a printed copy. Column 10, lines 13-20 disclose encoding a token (or glyph, as per '686) that relates to another electronic document for the purpose of linking the other document. This is evident because the encoded glyph is disclosed by that section to include a machine readable hypertext pointer values, and hypertext links point to electronic documents. Column 8, lines 38-47 describe the actual generation of the tokens. Lines 47-50 of that same column disclose printing the encoded glyphs onto a paper document.

Claims 2, 11, and 20:

Zdybel discloses an electronic scanner for reading the encoded tokens in, for example, column 9, lines 46-53.

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Claims 3, 12, and 21:

Zdybel column 9, lines 41-45 and 53+ disclose that the token is recognized by a workstation (i.e., information is recovered from the glyph). A processor is inherent for performing this step.

5 Claims 5, 14, and 23:

Zdybel figure 4 discloses the printing of a human readable identifier (element 45) relating to a token printed on the paper document. See associated text in column 10, lines 40-50.

Claims 6, 15, and 24:

10 A memory/storage means for storing the generated tokens is inherent in the Zdybel patent as per figure 5.

Claims 8, 17, and 26:

15 Encryption of the encoded tokens of Zdybel is disclosed in claim 17 of that patent.

Claims 9, 18, and 27:

Zdybel discloses encoding of authentication information in column 5, lines 2-6.

20 ▶ **Under 35 USC § 103**

▶ ▶ **Withdrawn**

The rejections of claims 1-27 under section 103(a) as being unpatentable over Lamming '321 in view of Zdybel '686 are withdrawn.

25 ▶ ▶ **New**

Claims 4, 7, 13, 16, 22, and 25 are rejected under 35 USC § 103(a) as being unpatentable over Zdybel '686.

Claims 4, 13, and 22:

30 Zdybel does not explicitly or implicitly disclose the actual retrieval of an electronic document based on the printed, recognized tokens. However, there is clear motivation in the Zdybel patent for the person of ordinary skill to include this step in the practicing of that invention. Column 10, lines 13-20 disclose encoding a pointer to an electronic document in the token. Column 3, lines 54-60 disclose, as shortcoming of the prior art in document hard copies, that printed
35 documents often do not include the links provided by the pointers contained in their corresponding electronic forms. The person of ordinary skill, given the fact that the Zdybel patent does explicitly disclose including a hypertext pointer in a token, would be motivated to use said pointer to retrieve the electronic document it references.

40 Claims 7, 16, and 25:

Zdybel does not explicitly disclose encoding data in a token relating to the owner of the document, nor is this feature inherent in the disclosure of that invention. This feature would, however, be obvious to the person of ordinary skill given the disclosure that is present in that invention. Column 4, line 64 through column 5, line 2 disclose that the tokens may be used to

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the owner as part of this meta-data comes from the Zdybel reference itself, as per column 4, lines 16-19, wherein Zdybel states as background that fundamental attributes of an electronic document, such as the author (owner), are seldom included in the hard copy representation of the document. As Zdybel recognized this as a shortcoming of the prior art, and provides a system that can correct that shortcoming, the person of ordinary skill would have sufficient motivation to include information relating to the owner of a document in the token of Zdybel.

Response to Remarks

Applicant has asserted that, under the Intellectual Property and Communications Omnibus Reform Act of 1999, neither Lamming nor Zdybel may be used as prior art. Examiner agrees that, as Lamming qualifies as prior art only under section 102(e), and was subject to the same obligation of assignment as the instant application, Lamming cannot be used as prior art under sections 102(e) or 103(a). For this reason, the previous rejections under section 103 over Lamming in view of Zdybel have been withdrawn.

Examiner respectfully disagrees with Applicant's levying of this same argument against the Zdybel patent. The instant application was filed on November 24th 1997, which makes the statutory bar date, under section 102(b), fall on November 24th 1996. As the Zdybel patent was issued on January 23rd 1996, before the one year statutory bar date, it does not fall under the provisions of section 103(c), because that section clearly states that patentability will not be precluded by a reference only if that reference "qualifies as prior art *only* under one or more of subsections (e), (f), and (g) of section 102" (emphasis added). As the Zdybel patent qualifies as prior art not only under section 102(e) (as per its filing date), but also under section 102(b) (as per its publication date), it can be applied as prior art under sections 102(b) and/or 103(a).

Upon further consideration of the instant application, examiner has concluded that the broadly worded independent claims are fully anticipated by the Zdybel patent. A rejection has been made under section 102(b) to that effect. In addition, there are other prior art references, cited below but not applied, that anticipate the feature of linking a hard copy document to an electronic document via a printed token.

Conclusion

The following prior art made of record but not previously cited is considered pertinent to the applicant's disclosure:

1. Faulkner '270 discloses printing a bar code along side the address that it encodes.
2. Hecht '833 discloses printing of glyphs on hard copy by a printer.
3. Petrie '010 discloses printing of glyphs on hard copy by a printer.
4. Collins '177 discloses printing of encoded document meta-data on a paper copy.

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5. Wellner '193 discloses encoding of a link to another electronic document on a paper copy of a document.

5 6. Sotomayor '825 discloses linking of electronic documents to each other.

7. Hoddie '595 discloses printing of encoded document meta-data on a paper copy.


10 8. Yamunachari '476 discloses glyphs of physical links.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony DiLorenzo, whose telephone number is (703) 306-5617. If the examiner is not available, a voice mail greeting will indicate when the examiner will return to the office. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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25 December 8, 2000

AD
12/8/00